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In re Application of :
PARKER et al. :
U.S. Application No. 09/762,562 : DECISION ON PETITION
PCT No.: PCT/US98/16521 :
Int. Filing Date: 10 August 1998 :
Priority Date: None :
Attorney Docket No.: 381-23-014 :
For: ELECTRIC ARC MONITORING :
SYSTEM :
:

This is a decision on applicants' "WITHDRAWAL OF PETITION UNDER 37 CFR 1.47(a) and SUBMISSION OF DECLARATION UNDER 37 CFR 1.42" filed 13 February 2002, to accept the application without the signature of joint inventor, Howard M. Ham. The signing joint inventors request that the above-captioned national stage application be accorded status under 37 CFR 1.42 without the signature of joint inventor Howard M. Ham due to their inability to "obtain the signature of Howard M. Ham, Jr., to no avail. Howard M. Ham is deceased."

BACKGROUND

On 10 August 1998, applicants filed international application PCT/US98/16521 which claimed no priority date and designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the international filing date, or at midnight on 10 February 2001.

On 09 February 2001, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and international application.

On 29 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 29 August 2001, applicants filed: "Transmittal of Missing Requirements under 35 U.S.C. 371"; a declarations and power of attorneys signed by three of the four joint inventors; a petition under 37 CFR 1.47(a) and the requisite fee; and a petition for a three-month extension of time and the requisite fee. The petition was dismissed in a decision dated 11 December 2001.

On 13 February 2002, applicant filed "Withdrawal of Petition under 37 CFR 1.47(a) and Submission of Declaration under 37 CFR 1.42."

DISCUSSION

A. Prior Petition under 37 CFR 1.47(a)

As stated in section 409.03(c) of the Manual of Patent Examining Procedure (M.P.E.P.) "37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application." Petitioner has provided a declaration executed by the legal representative of the deceased inventor, therefore, the petition for status under 37 CFR 1.47(a) is dismissed as moot.

B. Submission under 37 CFR 1.42

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration filed 13 February 2002 is executed by Lillian Margaret Ham as the "legal representative" of the deceased inventor, Howard M. Ham. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(b)(2), the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 13 February 2002 does not provide the citizenship of the legal representative. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

The prior petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

The request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.63 and 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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